

### III. REMARKS

Claims 1-26 are pending in this application. By this amendment, claims 1, 4-6, 9, 10, 13, 17, 21 and 23 have been amended. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. 1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicants respectfully request entry of this Amendment.

In the Office Action, claims 1-26 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Carroll (U.S. Patent No. 6,683,631), hereafter "Carroll."

With regard to the 35 U.S.C. §102(e) rejection over Carroll, Applicants assert that Carroll does not teach each and every feature of the claimed invention. For example, with respect to independent claims 1, 9, 17, 21 and 23, Applicants submit that Carroll fails to teach selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data. In contrast, the portion of Carroll cited by the Office teaches, "...in the illustrated embodiment, the user wishes to extend the selected region 106 to the end of the sentence." Col.

3, lines 28-30. Interpreting Carroll solely for the purpose of this paper, Carroll teaches a selected region that can be extended. To this extent, the Office equates the extended portion of the region that is extended from the selected region of Carroll with the selection of the second set of data of the claimed invention. However, by its very nature as an "extension" from the selected region, the extended portion of Carroll must be contiguous with the selected region, and, therefore, cannot be anywhere in the electronic document irrespective of the location of the selected region.

In contrast, the claimed invention includes "...selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data." Claim 1. As such, unlike the extended portion of Carroll, in the claimed invention, the second set of data of the claimed invention may be anywhere within the application irrespective of a location of the first set of data. Thus, the selecting of the second set of data is not taught by the extending of Carroll. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With further respect to independent claims 17, 21 and 23, and with respect to dependent claims 4 and 10, Applicants submit that the Carroll also fails to teach or suggest selecting, in a distinctive manner, a portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during the selection of the portion. Rather, the portion of Carroll cited by the Office teaches "...provid[ing] a system and method that permits a user to make a first selection, perform a process, and then make further modifications to the first selection." Col. 2, lines 23-26. As such, a user in Carroll may make a first selection and modify the first selection, but this particular passage is not clear in way the first selection may be modified. The

Office further cites a portion of Carroll that states "...[t]he steps presented in FIG. 2 can be repeated until all of the target information is selected, as depicted in FIGS. 5 and 6." Col. 5, lines 8-10. To this extent, the steps of FIG. 2 and accompanying text contain the processes that are used to make and modify the selection. In the text accompanying FIG. 2 of Carroll, two ways are illustrated to "select" information that is within the bounds of the overall selected region. In the first, "[i]f the information was previously selected, then it will remain selected." Col. 3, lines 55-57. To this extent, a region within the overall selected region that is "selected" again is not distinguished from the overall selected region. In the second, if a region within the overall selected region was deselected and later a portion of the deselected region is selected, then there would be a selected region within the deselected region within the overall selected region. However, this process describes selection of a region that was previously unselected and, thus, the selection is not of a selected set of data that remains selected during the selection of the new region.

The claimed invention, in contrast, includes "...selecting, in a distinctive manner, a portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during the selection of the portion." Claim 17. As such, the selection of the portion as included in the claimed invention, does not merely select information that was previously unselected or retain the selection of previously selected information that is selected as in Carroll, but instead selects a portion of one of the selected sets of data in a distinct manner, such that the selected set of data from which the portion is selected remains selected during the selection of the portion. For the above reasons, the selection of the portion as included in the claimed invention

is not taught by the modifying of the first selection of Carroll. Accordingly, Applicants request that the rejection be withdrawn.

With respect to dependent claims 6 and 13, Applicants submit that the Carroll also fails to teach or suggest that the method is adapted to allow selection of the second set of data that is non-contiguous with the first set of data. In contrast, the portion of Carroll cited by the Office teaches "...allow[ing] users to process target information when the target information regions are noncontiguous without having to select and process each of the noncontiguous target information regions separately." Col. 2, lines 6-8. To this extent, the object that is given in the above cited section of Carroll is at odds with the claimed invention, in which "...the method is adapted to allow selection of the second set of data that is non-contiguous with the first set of data." Claim 1. As such, in contrast to Carroll, in which the user does not select noncontiguous target information regions separately, the method of the claimed invention is adapted to allow selection of the second set of data that is non-contiguous with the first set of data. Carroll does not teach the independent selection the non-contiguous sets of data of the claimed invention. Accordingly, Applicants request that the rejection be withdrawn.

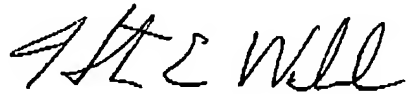
With regard to the Office's other arguments regarding dependent claims, Applicants herein incorporate the arguments presented above with respect to independent claims listed above. In addition, Applicants submit that all dependant claims are allowable based on their own distinct features. However, for brevity, Applicants will forego addressing each of these rejections individually, but reserve the right to do so should it become necessary. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

#### IV. CONCLUSION

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. These features have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



Hunter E. Webb  
Reg. No.: 54,593

Date: March 31, 2006

Hoffman, Warnick & D'Alessandro LLC  
75 State Street, 14<sup>th</sup> Floor  
Albany, New York 12207  
(518) 449-0044  
(518) 449-0047 (fax)

RAD/hew